

REMARKS

Claims 1-48 are pending in the application, and are subject to a restriction requirement.

Restriction Requirement

Pursuant to the restriction requirement, it was requested that Applicants select one of the following inventions under 35 U.S.C. §1.121 for prosecution:

- I. Claims 1-10, 12-23, 46, drawn to an apparatus, classified in class 422, subclass 55.
- II. Claim 11, drawn to a method of testing milk, classified in class 436, subclass 23.
- III. Claims 24-36, 47-48, drawn to a cartridge, classified in class 422, subclass 99.
- IV. Claims 37-43, drawn to a cartridge loader, classified in class 422, subclass 63.
- V. Claims 44-45, drawn to a method of loading cartridge, classified in class 436, subclass 46.

It was stated that the inventions were distinct from each other for a number of reasons.

Inventions II and I were said to be related as a process and apparatus for practicing it. It was asserted that the inventions are distinct if it can be shown that either:

1) the process as claimed can be practiced by another materially different apparatus or by hand; or

2) the claimed apparatus can be used to practice another materially different process. MPEP § 806.05(e) was relied upon for this assertion. In this instance, it was alleged, the apparatus can be used to test samples other than milk. It

was noted that the invention of Group II would be suitable for a rejoinder with Group I upon an indication of allowability of claim 1. Office Action, page 2.

Inventions IV and III were said to be related as an apparatus and a product made. The inventions were asserted to be distinct in this relationship if either or both of the following can be shown:

- 1) the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product; or
- 2) the claimed product can be made by another and materially different apparatus. MPEP, § 806.05(g), was cited in support of this assertion.

It was additionally asserted that in this application, the apparatus can be used to make cartridges not having the claimed structure e.g., a cartridge having a side charge opening and a lower discharge opening. *Id.*, at pp. 2-3.

Inventions V and III were said to be related as a process of making and product made. It was alleged that inventions are distinct if either or both of the following can be shown:

- 1) the claimed process can be used to make another and materially different product; or
- 2) the claimed product can be made by another and materially different process. MPEP, § 806.05(f) was relied upon for this assertion. In this application, it was asserted, the cartridge can be made by hand or by manually inserting slides in the cartridge. Office Action, page 3.

Inventions V and IV were said to be related as process and apparatus for practicing the process. It was asserted that these inventions are distinct if it can be shown that either:

1) the claimed process can be practiced by another and materially different apparatus or by hand; or

2) the claimed apparatus can be used to practice another and materially different process. § 806.05(e) of the MPEP was cited for support of this assertion. In the instant case, it was asserted that the apparatus can be used to load cartridges which are provided in a line on the same level as the columns, the lifter lifting each test piece in turn to be pushed laterally into a side opening of the cartridge and allowed to drop into the cartridge. *Id.*, at p. 3.

Finally, it was asserted that inventions of [I and II] and [III, IV, V] are related as subcombinations disclosed as useable together in one combination. The subcombinations, according to the Office Action, are distinct, if they do not overlap in scope and are not obvious therein and if it is shown that at least one subcombination is separately useable. In this application, according to the Office Action, subcombination [I, II] has a separate utility, e.g., testing using test pieces not supplied in cartridges, and subcombination [III, IV, V] has a separate utility, such as forming cartridges used with different testing devices. MPEP, §806.05(d) was cited as support.

It was concluded that because the inventions are independent or distinct, for the reasons discussed in the Office Action, and have acquired a separate status in the art in view of their allegedly different classification and divergent subject matter, restriction for purposes of examination was proper. Office Action, pages 3-4.

Applicants traverse the restriction requirement, and elect Group I, claims 1-10, 12-23 and 46 for prosecution.

It is well established that when all claims in the application can be searched and examined together without serious burden, the PTO must examine the claims on the merits even though they include claims to independent and distinct inventions. See,

MPEP, § 803. In establishing that a "serious burden" would exist for co-examination of claims, the PTO must show with an appropriate explanation one of the following:

- (a) the restricted groups have a separate classification,
- (b) each invention acquired a separate status in the art even though the inventions are classified together; or
- (c) searching would require different fields of search.

See MPEP at §808.02.

In this application, claims of Groups II and I, while patentably distinct from each other, are directed to similar subject matter, insofar as the method of claim 11 is conducted with the testing device of claim 1. For at least this reason, these two groups of claims should be examined together.

Claims of Groups IV and III are also patentably distinct from each other. Nonetheless, claims of Group IV are directed to a load device for loading a stack of testing devices into a cartridge, and claims of Group III to a cartridge which receives, stores and unloads a plurality of stacked testing devices, respectively. Thus, these claims are also generally related to each other, as underscored by their classification in the same class 422, though different subclasses. For at least these reasons, these two groups of claims should also be examined together.

Claims of Groups V and III, while patentably distinct from each other, are related by subject matter, insofar as Group V is directed to a method of loading a plurality of testing devices into a cartridge, while claims of Group III to a cartridge which receives, stores and unloads a plurality of stacked testing devices.

Claims of Group V, while patentably distinct from those of Group IV, are directed to similar subject matter, insofar as claims of Group V are directed to a method for

loading a plurality of testing devices into a cartridge with a load device, while claims of Group IV to a load device which loads a stack of testing devices into a cartridge. Thus, co-examination of these two groups of claims will not present a serious burden.

Applicants agree that inventions [I, II] and [III, IV, V] are patentably distinct from each other. Nonetheless, Applicants respectively submit that these five groups of claims should be examined together, at least because they are directed to similar subject matter, as underscored by classification of the groups in classes 422 and 436, although in different subclasses. The classification of Groups I, III and IV in class 422 (although in different subclasses) and Groups II and V in class 436 (though also in different subclasses) is not necessarily an indication that they have acquired a separate status in the art for purposes of searching.

For all of the above reasons, Applicants respectively submit that examination of all the claims in a single application would not present a serious search and examination burden on the PTO. The search of the subject matter of any one of the Groups I-V is likely to identify items of information which might be relevant to the prosecution of any of the other Groups or possibly all of the other Groups.

In view of the above remarks, it is respectfully requested that the restriction requirement be withdrawn and that all claims be allowed to be prosecuted in the same patent application. In the event that the requirement is made final and in order to comply with 37 C.F.R. § 1.143, Applicants provisionally elect with traverse claims 1-10, 12-23 and 46 (Group I), holding claims 11, 24-45, 47 and 48 (Groups II-V) in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

III. Request for Allowance

Applicants respectfully submit that all claims are in condition for allowance, an indication of which is solicited.

In the event any outstanding issues remain, Applicants would appreciate the courtesy of a telephone call to the undersigned Applicants' representative to resolve such issues in an expeditious manner and place the application in condition for allowance.

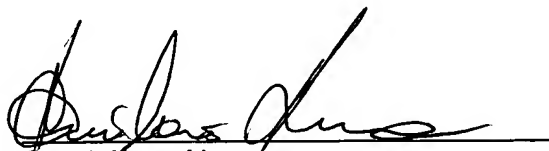
It is believed that no fees are due. However, in the event that any other fees are necessary, the Director is hereby authorized to charge such fees or credit overpayment to our Deposit Account No. 50-0206.

Respectfully submitted,

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